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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/932,784	09/18/1997	JAMES A. MCKAIN	A0521/7125	5693

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EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

501

Office Action Summary	Application No. 08/932,784	Applicant(s) MCKAIN ET AL.	
	Examiner HUY T NGUYEN	Art Unit 2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-2 and 4- 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washino et al (5,488,433) in view of Freeman et al (5,579,239) and Osamu (JP405153448).

Regarding claims 1-2, 9 and 23, Washino et al. discloses a digital motion picture recorder (Figs 1 and 2) comprising a motion picture camera (video camera) for providing a motion video signal; means (6, 740) converting the motion video signal into a sequence of digital still images and compressing the sequence of digital still image (column 4, lines 57-68); and means for storing the sequence of digital still images on a

rewritable random-access medium (70) in a computer readable file form (column 10, lines 9-25).

Regarding claims 4, Washino et al. further discloses a editing system (Fig 2) and a display means (view finder 4)

Regarding claims 5-6, Washino et al. further teaches that the digital medium is a disk- type drive (70) and the disk- type drive is mounted in a housing detachable from the housing of the digital motion picture recorder.

Washino fails to teaches a editing means that specifies sequence of the stored digital still picture . However, it is noted that using a editing means for specifying a sequence of stored digital video signal is well known in the art as taught by Freeman. Freeman teaches an editing means (2) with in a computer for editing a video signal captured from a video camera and recorded on a random access memory (column 2, line 59 to column 3, line 7, column 6, lines 8-20, Fig. 2). Therefore , it would have been obvious to one of ordinary skill in the art to modify Washino with Freeman by installing the editing means as taught by Freeman in the recorder of Washino to enable edit the stored digital still pictures by specify a sequence of the still digital still pictures, thereby providing more convenience to the user in editing the stored digital sill picture.

Washino as modified with Freeman fails to teach that the editing means is with the housing of the recorder. However, it is noted that install editing means within a housing of a recorder is well known in the art as taught by Osamu (JP405153448). Osamu teaches a video camera having an editing means within the housing of the camera .

It would have been obvious to one of ordinary skill in the art to modify Washino as modified with Freeman with Osamu by using the teaching of Osamu to install the editing means as taught by Freeman within the recorder of Washino thereby provide more convenience to the user in handling the editing the captured digital data.

Regarding claims 4, 10, 24, Washino as modified with Freeman further teaches a display and editing control to edit and display the sequence of the still picture (See Freeman, Fig. 2)

Regarding claims 5,6,12, 13, 15, 26, 27, 40, Washino as modified with Freeman teaches that the medium is a random access medium and a disk type is detachable (Hard disk drives, See Washino and Freeman .

Regarding claim 7, Washino as modified with Freeman fails to specifically teach that the portable housing is ruggedized. However, it is noted that ruggedizing a device is well known in the art and also it is required by customer. Therefore, it is would have been obvious to one of ordinary skill in the art to make the housing of the recorder of Washino as modified with Freeman to be ruggedized in order to provide the digital recorder with more endurance.

Regarding claims 11, 25, 38, Washino as modified with Freeman and Osamu further teaches display functions associated with an input mechanism. See Freeman and Osamu references.

Regarding claims 14,28 and 39, Washino as modified with Freeman fails to the housing comprise a shell and a shock absorbing cushions between the shell and disk type drive. However, it is noted using a shock absorbing cushions to prevent vibration

and firmly hold a part is well known in the art. Therefore Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Washino as modified with Freeman by incorporating a shell and a shock absorbing cushions between the shell and disk drive to prevent the vibration of the disk.

Regarding claims 16, 17,30, 31 and 42, Washino as modified with Freeman further teaches the use of data address bus provide data to a computer network (See is well known in the art. Therefor it would have been obvious to one of ordinary skill in the art to modify Peter by providing data address bus to provide still digital images to a computer interface to transmitting the still digital to a designated destination (See Freeman, column 6).

Regarding claims 8, 18 and 32, Washino as modified with Freeman fails to teach the calibration of the color of the still digital picture. However, it is noted that using means for calibration color of the picture is well known in the art. Therefore, Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Washino as modified with Freeman by using a means for calibrating the color of the digital still picture in order to improve the quality of the digital still picture.

Regarding claim 19,33 and 43, Washino as modified with Freeman fails to specifically teach the means for overlaying information indication of time code or date on the digital still picture signal. However, it is noted that overlay date or time code or information on a picture is well known in the art. Therefore the Official notice is taken and it would have been obvious to one of ordinary skill in the art to modify Washino as modified with Freeman by using means for generating time code or date and

overlaying the date or time code on the digital still picture in order to accurately identify the still picture.

Regarding claims 20,21,34,35 and 44, Washino as modified with Freeman further teaches the use of encoder (compressing means) for encoding the video signal.

Regarding claims 22, 36 and 37, Washino as modified with Freeman further teaches that the digital still picture is conforming to NTSC format.

3. Claims 1-2 and 4- 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al (5,946,445) in view of Bohrman and Osamu (JP405153448).

Regarding claims 1-2, 9 and 23, Peters discloses a digital motion picture recorder comprising:

- a housing sized to be portable for use by an individual (Fig. 1);

- processing means (Fig. 1) in the housing for receiving the motion video signal from a video camera and a processing the received motion video signal;

- a converting means for converting the motion video signal into a sequence of the still image (column 2);

- storage means (5) for storing the sequence of still images on a computer readable and rewritable random access medium mounted in the housing (column 3).

Peters at fig 1 fails to specifically teach that the motion camera mounted in the housing having the recorder. However, it is noted that combining a camera with recorder for making a portable apparatus is well known in the art as taught by Osamu . Therefore, it would have been obvious to one of ordinary skill in the art to modify the digital recorder of Peters by providing a motion camera in the same housing of the digital

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recorder for portability 's purpose therefore providing more advantages to the user in capture the desired the motion signal .Also See Peter he specification of the instant application page 4) and it is well recognized that a camera which integral with a digital recorder to make portable is well recognized in the art.

Peters as modified with Osamu further teaches the use of an editing unit for editing the recorded digital still picture but fails to specifically teaches that the editing means is used for specifying a sequence of the stored digital picture to be played back.

Bohrman teaches an editing unit which is used with a computer for editing the prestored video information, defining a sequence of the still video information to be reproduced .

It would have been obvious to one of ordinary skill in the art to modify Peters with Bohrman by using an editing device as taught by Bohrman in the apparatus of Peters for editing the video information stored on the medium in order to provide convenience to the user in editing the digital still picture.

Regarding claims 4, 10, 24, Peters as modified with Bohrman further teaches a display and editing control to edit and display the sequence of the still picture (See Peters column 3, lines 30-40 and Bohrman (Fig. 2, column 1, lines 15-25 column 2, lines 15-25)

Regarding claims 5,6,12, 13, 15, 26, 27, 40, Peter as modified with Bohrman teaches that the medium is a random access medium and a disk type is detachable .

Regarding claim 7, Peters fails to specifically teach that the portable housing is ruggedized. However, it is noted that ruggedizing a device is well known in the art and also it is required by customer. Therefore, it would have been obvious to one of ordinary skill in the art to make the housing of the recorder of Peters is ruggedized in order to provide the digital recorder with more endurance.

Regarding claims 11, 25, 38, Peter as modified with Bohrman fails to teach display functions associated with an input mechanism. However, it is noted that using display function and an input mechanism associated with display function to enabling a user to select an associated function is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to modify Peters as modified with Bohrman to provide display functions and associated input mechanism in order to provide more convenience to the user in operation the digital recorder.

Regarding claims 14,28 and 39, Peters fails to the housing comprise a shell and a shock absorbing cushions between the shell and disk type drive. However, it is noted using a shock absorbing cushions to prevent vibration and firmly hold a part is well known in the art. Therefore Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Peters by incorporating a shell and a shock absorbing cushions between the shell and disk drive to prevent the vibration of the disk.

Regarding claims 16, 17,30, 31 and 42, Peters fails to specifically teach the use of a data address bus to provide the digital still image to a computer interface. However, it is noted that using a data address bus to provide data to a computer network is well known in the art. Therefor it would have been obvious to one of ordinary skill in the art

to modify Peter by providing data address bus to provide still digital images to a computer interface to transmitting the still digital to a designated destination.

Regarding claims 8, 18 and 32, Peters fails to teach the calibration of the color of the still digital picture. However, it is noted that using means for calibration color of the picture is well known in the art. Therefore, Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Peters by using a means for calibrating the color of the digital still picture in order to improve the quality of the digital still picture.

Regarding claim 19,33 and 43, Peters fails to specifically teach the means for overlaying information indication of time code or date on the digital still picture signal. However, it is noted that overlay date or time code or information on a picture is well known in the art. Therefore the Official notice is taken and it would have been obvious to one of ordinary skill in the art to modify Peters by using means for generating time code or date and overlaying the date or time code on the digital still picture in order to accurately identify the still picture.

Regarding claims 20,21,34,35 and 44, Peters fails to teach the use of encoder for the digital still picture. However, it is noted that using an encoder for encoding video signal comprising digital still pictures is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to modify Peters by using an encoder for the digital still picture for encoding the digital still picture.

Regarding claims 22, 36 and 37, Peters further teaches that the digital still picture is conforming to NTSC format.

Response to Arguments

4. Applicant's arguments filed Jan. 22, 2002 have been fully considered but they are not persuasive.

In Remarks, applicants argue that there is no reference at the time the invention was made to show a camera within the housing of recorder. However, it is noted that incorporating a recorder with a housing of a camera is well known in the art as taught by Washino and Osamu.

In Remarks, applicants argue that "a portable video system as taught in Peter would still receive a signal from an external device . . . rather than Applicants a putting together a video system including an editor with a camera which is not even part of Peters". In response, it is submitted that when the camera and the digital recorder as disclosed by Peters are put together to form a portable video system, the signal would be received by the video system. Further, it is noted that putting a camera and a digital recorder to form a portable video system is well recognized in the art.

Furthermore, it is noted that using an editor together with a recording/ reproducing apparatus is well known in the art as taught by Bohrman, Bohrman teaches an editor which is used with a recording/reproducing apparatus to edit the video signals.

Therefore, it would have been obvious to one of ordinary skill in the art to using an editor as taught by Bohrman with the digital recorder as taught by Peters to edit the motion picture which comprises a sequence of the still images disclosed by Peters.

Since using an editor in associated with a digital recording/reproducing apparatus

would provide more convenience to the user in editing the images and this is a motivation that would lead a practitioner in the art to use an editor with the video system of Peters. Since the claimed video system is merely formed by the well-known parts putting together, the combination of a camera, a digital recorder as taught by Peters and the editor as taught by Bohrman would produce the claimed video system.

Applicants argue that the only the reason to provide convenience to the user, this lack of evidence to support the examiner allegation of the motivation to combine prior art reference renders the rejection improper. In response, it is noted that incorporating an editing means in recorder integrated with a camera is well known in the art at the time the invention was made. The uses of editing means in the a recorder integrated with camera would enhance the capacity and function of the modified recorder to allow a user to create the desired and edited images. Therefore providing more convenience to the user to edit the moving information his owns creation and interest. Applicants further argue that Osamu fails to teach or suggest a specific kind of editing means, one that allows a user to specify a sequence of stored motion information. In response, the examiner relies on the teaching of incorporating an editing means in a camera of Osamu to provide the fact that an editing means incorporated in a camera is known in the art at the time the invention was made. The editing of a sequence of the motion information is taught by Washino and Freeman and Peters and Bohrman.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bluth and Silverbrook teach a digital camera having an editing function. Takahashi et al teaches a recorder for recording moving picture from a camera and editing the moving picture.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TECH CENTER 2600 customer service whose telephone number is (703) 306-0377.

H.N
May 6, 2002


HUY NGUYEN
PRIMARY EXAMINER